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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,321	01/06/2005	Serge Creutz	SN132 PCT 1	9052
137 7590 04/09/2008 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994				
EXAMINER PENG, KUO LIANG				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
04/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

Office Action Summary

Application No.

10/521,321

Applicant(s)

CREUTZ ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/19/08 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,10,11,15-17,19 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,10,11,15-17,19 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed February 19, 2008 has been entered. Claims 1, 3-4, 10-11, 15-17 and 23 are amended. Claims 2, 5-9, 12-14, 18, 20-22 and 24-26 are deleted. Now, Claims 1, 3-4, 10-11, 15-17, 19 and 23 are pending.
2. Claim objection(s) in the previous Office Action (Paper No. 101307) is/are removed.
3. Double patenting rejection(s) in the previous Office Action (Paper No. 101307) is/are removed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-4, 10-11, 15-17, 19 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1 (line 16) and 23 (line 19), it is not clear as to what “a **mixture** of glycerol triesters” refers to. (Emphasis added)

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 3-4, 10-11, 15-17, 19 and 23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Examiner is not able to find the basis of fatty acids **in general**. (Emphasis added)

Claim Rejections - 35 USC § 102 and 103

8. Rejection of Claims 1, 3, 10-11, 15-17, 19 and 23 under 35 USC 102(a) as being anticipated by Dickinson (GB 1 523 957) is maintained because the rejection is adequately set forth in paragraph 7 of Paper No. 101307. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

The instant rejection will be removed when the rejections under 35 U.S.C. 112 are properly overcome.

9. Claims 1-5, 7-11, 13, 15-17, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US 6 610 752) in view of L'Hostis (EP 1 075 863).

The following column and line numbers of L'Hostis is based on its U.S. equivalent, US 6 521 587.

For Claims 1-5, 7-11, 13, 15, 17, 19 and 23, Schmid discloses a method of manufacturing a granular foam control composition comprising a **polydiorganosiloxane** containing methyl, ethyl, propyl, butyl and phenyl groups, a **microfine silanized silica**, a **polyol ester** such as the esters of glycerol and palmitic acid (typically containing a mixture of **glycerol mono, di-, and**

tripalmitate), etc., a bisamide, a **fatty acid**, a microcrystalline paraffin wax. (col. 2, line 34 to col. 5, line 56 and Examples) The silica can be silanized and dispersed in the polydiorganosiloxane. (col. 2, line 34 to col. 3, line 18) The granular foam control composition can be prepared according the method described in col. 3, line 19 to col. 4, line 13, col. 5, line 57 to col. 7, line 67 and Examples. Schmid is silent on the polydiorganosiloxane where the substituents have the claimed mean number of carbon atoms, the claimed long chain alkyl group or the claimed X-Ph moiety. L'Hostis teaches the use of in a foam control composition a polyorganosiloxane that read on the claimed ones. The motivation of using the specific polyorganosiloxane is to afford a granular foam control composition with **enhanced foam control efficiency**. (col. 2, lines 46-51, col. 2, line 64 to col. 3, line 46, col. 4, line 64 to col. 5, line 28 and col. 7, line 65 to col. 8, line 35) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize L'Hostis' polyorganosiloxane in Schmid's composition with expected success. Especially, L'Hostis is in the same field as that of Schmid's endeavor. Schmid teaches depositing the polydiorganosiloxane, polyol ester, etc. in aqueous liquid form onto the particular carrier. (col. 2, lines 5-30) However, the water is eventually removed. (col. 22, lines 12-25) As such, the prior art's granulated foam control composition is

obviously the same as the claimed granulated foam control composition where the polydiorganosiloxane, polyol ester, etc. is used in non-aqueous form. For Claim 16, Schmid is silent on the **microfine** silanized silica having the claimed average particle size. However, L'Hostis teaches that it is well known to use hydrophobic fillers such as silica with particle size of 0.5 to 50 **microns** for foam control agents. The silica is well known and is **commercially available**. (col. 6, line 60 to col. 7, line 28) As such, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize L'Hostis' silica filler in Schmid's composition because Schmid's silica is **microfine** and the commercial availability of L'Hostis' silica. Especially, L'Hostis is in the same field as that of Schmid's endeavor, and Applicants do not show the **criticality** of the particle size.

For Applicants' argument (Remarks, page 13, 1st and 2nd paragraphs), Examiner disagrees because Schmid does teach the claimed polyol ester, *supra*. The motivation of combining Schmid and L'Hostis is adequately set forth above. Especially, L'Hostis is in the same field as that of Schmid's endeavor. Applicants are further reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1796

klp

March 28, 2008

/Kuo-Liang Peng/

Primary Examiner, Art Unit 1796